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EXAMINER

D'AGOSTINO, PAUL ANTHONY

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The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/827,657  
Filing Date: April 05, 2001  
Appellant(s): MCNUTT ET AL.

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Richard E. McNutt  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/4/2008 appealing from the Office action mailed 3/5/2007.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,722,980	Stronach	4-2004
6,364,768	Acres et al.	4-2002

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 11, 15, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Stronach (6,722,980).

Referring to claims 1 and 15, Stronach teaches a method and system for recognizing a wagerer (game player) of an interactive wagering application implemented at least partially on user equipment comprising:

user equipment (wagering terminal 120, Figs.2-4; 3:54-4:57, 13:66-14:19) configured for receiving racing data from a racing data provider (110, Fig. 1), wherein at least a portion of the racing data originates from at least one race track where races corresponding to the racing data are being run (3:30-51; 8:23-50);

allowing a wagerer to place a parimutuel wager on one of the races (4:43-57);

a wagering control system configured for selecting a wagerer, and determining if the wagerer is to be recognized based on one criterion of a plurality of criteria, wherein each criterion of the plurality of criteria is associated with a different incentive; and

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when the wagerer is determined to be recognized based on the one criterion, providing an incentive to the wagerer (game player) (10:66-11:14).

Note that, the claimed different incentive related to each criterion are inherent to the prize selection algorithm of Stronach wherein the prize is selected according to every certain amount of wager submissions, and further, payout tables maybe provided for the wager type other than the win wager type (11:5-14; 17:1-4).

Referring to claims 11 and 25, Stronach teaches providing the incentive to the wagerer comprises providing a discount on wagering service, i.e., credit is a discount (10:66-11:5).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stronach in view of Acres et al. (6,364,768).

Stronach teaches all limitations of claims 1, 11, 15, and 25 above. Stronach does not explicitly teach the limitation of determining if the to be recognized wagerer is a VIP (claims 5 and 19).

Acres et al., however, teaches a method and system for recognizing a wagerer (game player) of an interactive wagering application comprising: determining if the to be recognized wagerer is a VIP (8:35-61).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to provide the player tracking system of Acres et al. to the interactive racing system and method of Stronach to provide a friendly interactive gambling environment to encourage frequent players to come back as well as attract new players thus increase profit.

#### **(10) Response to Argument**

Applicant's arguments filed 8/7/12/2006 have been fully considered but they are not persuasive. The Applicant has essentially contended several different points.

1. The Examiner has not proven inherency with respect to Stronach showing the applicant's claimed feature of "determining if the wagerer is to be recognized based on one criterion of a plurality of criteria and providing the incentive associated with that one criterion to the wagerer."

2. The Examiner has "mischaracterized the prize selection algorithm of Stronach and that "the Examiner's implicit contention that there are payout tables associated with the prize selection algorithm is similarly without merit".

With respect to item 1, Stronarch teaches a prize selection algorithm. This algorithm as was noted in prior actions is used to determine a prize according to the particular amount of a wager submission. Prizes can be random or associated with a pay table. A pay table is well known in the art to correlate combinations of outcomes and wagers (See column 11 lines 6-14). A player is recognized on the criterion of a wagered amount and provided an incentive based on the credits awarded or other prizes (see column 10 line 66 through column 11 line 5). While Stronarch does not specifically indicate a pay table is associating outcomes and wagers, it is inherent based on the definition of a pay table. That is to say a correlation between wager and incentive is necessarily present in the concept of a pay table. See Continental Can Co. USA v. Monsanto Co. Thus, it is deemed to be inherent that a pay table correlates a wager with an incentive. Please see also the included definition of "pay table" from <http://www.slotmachinesabc.com/terminology/termsip.html>. For the reasoning provided, the rejection is respectfully maintained.

With respect to item 2, Applicant has argued that the payout tables are not associated with the prize selection. Specifically the Applicant states that "when Stronarch refers to payout tables for wager types other than the win wager type, Stronarch is referring to payout tables for the place wager type, the show wager type, the exacta wager type, the triacta wager type, etc." The examiner reasonably believes this is without consequence as pay tables are a prize selection algorithm especially as described by Stronarch column 16 line 44 through line 15 line 4. Even if Stronarch intends to reference pay tables for the place wager type, the show wager type, the

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exacta wager type, the triacta wager type, etc., these are also prize selection algorithms. Therefore, a pay table must be associated with a prize selection algorithm because they are indeed the same. Applicant states that wager payouts are not prizes and therefore, a pay table and a prize selection algorithm can not be the same.

However, on page 4 of the Remarks filed 8/7/2006 the quoted Stronarch column 10 lines 66 through column 11 line 5 for support saying "The prizes may include, for example, a credit to the users wagering account or other types of prizes". As Applicant has cited this reference for support, the Examiner takes this to mean Applicant admits that a prize and a payout are the same contrary to the assertion that payouts are not prizes on page 5 of the Remarks.

In summary, Stronarch does teach that 1) determining if the wagerer is to be recognized based on one criterion of a plurality of criteria and providing the incentive associated with that one criterion to the wagerer and 2) that there are payout tables associated with the prize selection algorithm. Stronarch does teach every limitation of Applicant's independent claims and thus rejections are respectfully maintained.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.



Respectfully submitted,

/Paul A. D'Agostino/

Examiner, Art Unit 3714

Conferees:

/John M Hotaling II/

Primary Examiner, Art Unit 3714

/Robert Pezzuto/

SPE Art Unit 3714

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. D'Agostino whose telephone number is 571-270-1992. The examiner can normally be reached on M-F: 8AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.